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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,890	09/28/2001	E. David Neufeld	COMP:0224	4334

7590 11/29/2006

Intellectual Property Administration
Legal Dept., M/S35
P.O. Box 272400
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EXAMINER

TESLOVICH, TAMARA

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 11/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/966,890

Applicant(s)

NEUFELD ET AL.

Examiner

Tamara Teslovich

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

This office action is in response to the Applicant's Amendments and Arguments filed September 19, 2006.

Claims 2, 7, 8, 12, 20, 21 and 28 remain cancelled.

Claims 36-40 are newly added.

Claims 1, 2-6, 9-11, 13-19, 22-27, and 29-40 are herein considered.

Response to Arguments

Applicant's arguments with respect to the Examiner's 35 USC 101 Rejection of claims 1, 3-6, 9-11, 13-19, 22-27, and 29-35 as directed to non-statutory subject matter have been fully considered but they are not persuasive.

As per the MPEP, specifically section 2106(2)(a), it is imperative that a claimed invention as a whole accomplishes a practical application and that it produces a "useful, concrete and tangible result." State Street, 149 F.3d at 1373, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (Brenner v. Manson, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96); In re Ziegler, 992, F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)).

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Apart from the utility requirement of 35 U.S.C. 101, usefulness under the patent eligibility standard requires significant functionality to be present to satisfy the useful result aspect of the practical application requirement. See *Arrhythmia*, 958 F.2d at 1057, 22 USPQ2d at 1036. **Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting.**

The claimed invention as a whole must produce a “useful, concrete and tangible” result to have a practical application.

Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” In this context, “functional descriptive material” consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of “data structure” is “a physical or logical relationship among data elements, designed to support specific data manipulation functions.” The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) “Nonfunctional descriptive material” includes but is not limited to music, literary works, and a compilation or **mere arrangement of data**. Both types of “descriptive material” are nonstatutory when claimed as descriptive material per se, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. See also *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). When nonfunctional descriptive material is recorded on some

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computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. **Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory.** See Diehr, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in Benson were unpatentable as abstract ideas because “[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.”). Such a result would exalt form over substance. In re Sarkar, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978) (“[E]ach invention must be evaluated as claimed; yet semantogenic considerations preclude a determination based solely on words appearing in the claims. In the final analysis under § 101, the claimed invention, as a whole, must be evaluated for what it is.”) (quoted with approval in Abele, 684 F.2d at 907, 214 USPQ at 687). See also In re Johnson, 589 F.2d 1070, 1077, 200 USPQ 199, 206 (CCPA 1978) (“form of the claim is often an exercise in drafting”). Thus, nonstatutory music is not a computer component, and it does not become statutory by merely recording it on a compact disk. Protection for this type of work is provided under the copyright law.

When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory and should be rejected under 35 U.S.C. 101. In addition, USPTO personnel should inquire whether there should be a rejection under 35 U.S.C. 102 or 103. USPTO personnel

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should determine whether the claimed nonfunctional descriptive material be given patentable weight. USPTO personnel must consider all claim limitations when determining patentability of an invention over the prior art. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 403-04 (Fed. Cir. 1983). USPTO personnel may not disregard claim limitations comprised of printed matter. See Gulack, 703 F.2d at 1384, 217 USPQ at 403; see also Diehr, 450 U.S. at 191, 209 USPQ at 10. However, USPTO personnel need not give patentable weight to printed matter absent a new and unobvious functional relationship between the printed matter and the substrate. See In re Lowry, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); In re Ngai, 367 F.3d

1336, 70 USPQ2d 1862 (Fed. Cir. 2004).

Applicant's arguments with respect to claims 1 and 19 and Utz's failure to disclose examining a state bit to determine whether the seed pool is full have been fully considered but they are not persuasive.

The Examiner would like to draw the Applicant's attention first to Utz's control circuit 208 which controls the RS/PRNG in its operations. More specifically, the Examiner would like to point to column 7 lines 21-25 and 60-62 as well as column 8 lines 5-9 wherein Utz discloses both a pushbutton (hardware) state indicator which "may be realized in software executing in a microcontroller in the receiving unit" as well as the use of modes (states), namely 'standby mode[s]' used to mark when enough codes have been generated (pool is full) and may be utilized to create a random number.

Applicant's arguments with respect to claims 13 and 17 and Utz's failure to disclose altering a signature value have been fully considered but they are not persuasive.

The Examiner disagrees with the Applicant's contention that Utz's start value remains static, drawing the Applicant's attention to column 8 lines 31-43 wherein it is disclosed how each pseudo-random value is different from the last, including all those generated after the first value, serving to protect from situations wherein an intruder may attempt to reset a system by removing a batter in an attempt to reset the value.

For those reasons given above, the Examiner maintains her rejection of claims 1, 3-6, 9-11, 13-19, 22-27, 29-35 under 35 U.S.C. 103(a) as being unpatentable over Bruce Schneier's "Applied Cryptography", hereinafter referred to as Schneier, and further in view of US Patent No. 5,680,131 to Utz et al., hereinafter referred to as Utz. The Examiner also maintains her 35 USC 101 Rejection of claims 1, 3-6, 9-11, 13-19, 22-27, and 29-35 as directed to non-statutory subject matter.

Claim Rejections - 35 USC § 101

Claims 1, 3-6, 9-11, and 33 remain rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter because it includes only non-functional descriptive matter with no tangible result.

Claims 13-18 remain rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter because it fails to produce any tangible result for those situations in which less than a predetermined portion of the signature value of the seed pool has been altered.

Claims 19, 22-26 and 34 remain rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter because it includes no tangible result.

Claims 27, 29-32, and 35 remain rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter because it fails to produce a tangible result for those situations in which the plurality of data bits has no portion of the signature value.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-6, 9-11, 13-19, 22-27, 29-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bruce Schneier's "Applied Cryptography", hereinafter referred to as *Schneier*, and further in view of US Patent No. 5,680,131 to Utz et al., hereinafter referred to as *Utz*.

Regarding **claim 1**, Schneier discloses a method of generating a random number for a cryptographic security subsystem of a processor-based device, the method comprising the acts of (a) detecting occurrences of a first type of triggering event (SCHNEIER page 426 lines 6-14); (b) writing one or more bits of data to a seed pool (or reservoir) upon termination of the first type of triggering event (SCHNEIER pages 424, 426); (c) detecting occurrence of a second type of triggering event; (d) writing one or more bits of data to the seed pool upon termination of the second type of triggering event, wherein act (d) comprises masking one or more bits of data to the seed pool upon termination of the second type of triggering event (SCHNEIER page 426 lines 16-17); (e) examining the state bit to determine whether the seed pool is full (page 428

lines 16-18); and (f) if the seed pool is not full, repeating acts (a) through (e) until (enough events have taken place) the seed pool is full (SCHNEIER page 428 lines 16-18).

Schneier fails to *specifically* mention determining if a seed pool is full or masking bits into the seed pool.

Utz discloses the act of masking (serially combining) the one or more bits of data into the seed pool (UTZ col.6 lines 57-61; col.5 line 22) as well as determining if the seed pool is full; and writing one or more bits of data to the seed pool upon termination of the second type of triggering event if the seed pool is not full (UTZ col.3 lines 38-40; col.11 lines 51-55).

It would have been obvious to a person of average skill in the area at the time of the invention to include within Schneier the Utz's ability to determine if a seed pool is full and masking bits into the seed pool in order to allow the cryptographic security subsystem in knowing when the pool is full and available for use in creating a random number.

Regarding **claim 3**, Schneier further discloses that the first type of triggering event has a variable duration (seemingly random events) (SCHNEIER page 426 lines 7-8).

Regarding **claims 4-6**, Schneier further discloses that the processor-based device is coupled to a communication link, and includes the act of receiving a communication from the communication link (arrival times of network packets), the link

comprising a plurality of types (network, multimedia, etc) (SCHNEIER page 426 lines 14-27).

Regarding **claim 9**, Schneier further discloses that act (d) comprises capturing the one or more bits of data from a free-running timer upon termination of the second type of triggering event (SCHNEIER 426 lines 37-34).

Regarding **claim 10**, Schneier further discloses that the second type of triggering event is different than the first type of triggering event (as many good sources of randomness as are available) (SCHNEIER 426 lines 37-34).

Regarding **claim 11**, Schneier further discloses that the second type of triggering event is a cycle of power applied to the processor-based device (SCHNEIER page 426 lines 12-13).

Regarding **claim 13**, Utz discloses a method of initializing a seed pool for generating a random number for a cryptographic security subsystem of a processor-based device, the method comprising the acts of (a) prior to enabling the cryptographic security subsystem, writing a plurality of bits of data to a seed pool (RS/PRNG), the plurality of bits of data having a signature (start) value (UTZ col.5 lines 34-42; col.6 lines 13-28); (b) detecting occurrences of a first type of triggering event and (c) writing one or more bits of data to the seed pool upon termination of the first type of triggering event, the one or more bits of data altering the signature value of the seed pool (col.6 lines 37-61); and (d) enabling the cryptographic security subsystem when more than a predetermined portion of the signature value of the seed pool has been altered (UTZ col.7 line 61 thru col.8 line 13; col.9 line 62 thru col.10 line 16).

Regarding **claims 14 and 15**, Utz discloses wherein the first type of triggering event comprises either a cycle of power applied to the processor-based device or a reboot of the processor-based device (power-on reset circuit) (UTZ col.5 lines 57-67).

Regarding **claim 16**, Utz discloses wherein act (c) comprises the act of masking (serially combining) the one or more bits of data into the seed pool (UTZ col.6 lines 57-61; col.5 line 22).

Regarding **claim 17**, Utz discloses wherein act (c) comprises the act of capturing the one or more bits of data from a free-running timer (clock signals) (UTZ col.5 lines 59-61) .

Regarding **claim 18**, Utz discloses detecting a second type of triggering event; determining if the seed pool is full; and writing one or more bits of data to the seed pool upon termination of the second type of triggering event if the seed pool is not full (UTZ col.3 lines 38-40; col.11 lines 51-55).

Claim 19 is directed towards a device's implementation of the method of claim 1 and is rejected by similar rationale.

Claim 22 is directed towards a device's implementation of the method of claim 3 and is rejected by similar rationale.

Claim 23 is directed towards a device's implementation of the method of claim 4 and is rejected by similar rationale.

Claim 24 is directed towards a device's implementation of the method of claim 5 and is rejected by similar rationale.

Regarding **claim 25**, Utz discloses wherein the interface controller

comprises an RS232 interface controller (UTZ col.7 lines 41-45; col.10 lines 48-53).

Claim 26 is directed towards a device's implementation of the method of claim 11 and is rejected by similar rationale.

Regarding **claim 27**, Utz discloses a processor-based device comprising: a host processing system, the host processing system comprising a processor and a communications management system in communication with the host processing system (UTZ col.5 lines 52-67); and a memory system in communication with the host processing system and the communications management system, wherein the communications management system comprises: an interface controller (UTZ col.6 lines 8-12); a non-volatile memory device to store a seed pool comprising a plurality of data bits (UTZ col.5 lines 34-42); and security logic in communication with the interface controller and the non-volatile memory device, the security logic configured to establish a secure communication session between the processor-based device and an external device in communication with the processor-based device via the interface controller (UTZ col.4 lines 47-60), and wherein the security logic is configured to: write the one or more bits to the seed pool, the bits altering a signature value; determine whether the plurality of data bits in the seed pool has at least a portion of a signature value; and disable establishment of the secure communication session if the plurality of data bits has at least a portion of the signature value (UTZ col.9 line 62 thru col.10 line 16).

Regarding **claim 29**, Utz discloses a main power supply to supply power to the processor-based device, and wherein the first type of triggering event comprises a cycle

of the power supplied by the main power supply (power-on reset circuit) (UTZ col.5 lines 57-67).

Regarding **claims 30-31**, Utz discloses wherein the security logic is configured to detect a second type of triggering event; determine whether the seed pool is fully populated; and write one or more data bits to the seed pool upon termination of the second type of triggering event if the seed pool is not fully populated (UTZ col.3 lines 38-40; col.11 lines 51-55) and wherein the second type of triggering event comprises receipt of a communication from the external device via the interface controller (UTZ col.3 lines 38-40; col.11 lines 51-55).

Regarding **claim 32**, Utz discloses wherein the interface controller comprises a network interface controller (UTZ col.7 lines 41-45; col.10 lines 48-53).

Regarding **claim 33**, Schneier further discloses the act of capturing one or more bits of data from a free-running timer (most finely grained time-of-day clock, for example the Intel 8254 clock chip) upon termination of the first type of triggering event (SCHNEIER page 426 lines 27-34).

Claim 34 is directed towards a device's implementation of the method of claim 33 (cancelled claim 2) and is rejected by similar rationale.

Regarding **claim 35**, Utz discloses wherein the security logic is configured to detect a first type of triggering event, and to write one or more data bits to the seed pool upon termination of the first type of triggering event (UTZ col.6 lines 37-61).

Regarding **claim 36**, Schneier discloses a method for restoring security data to non-volatile memory in a computer system comprising writing bits to a seed pool in

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discrete increments corresponding to a triggering event, wherein the seed pool is stored in a portion of a non-volatile memory device (pages 424, 426); tracking the state of the seed pool to determine if the seed pool is fully populated (page 428 lines 16-18); and precluding access to the computer system if it is determined that the seed pool is not fully populated (page 428 lines 16-18).

Schneier fails to *specifically* mention determining if a seed pool is full or masking bits into the seed pool.

Utz discloses the act of masking (serially combining) the one or more bits of data into the seed pool (UTZ col.6 lines 57-61; col.5 line 22) as well as determining if the seed pool is full; and writing one or more bits of data to the seed pool upon termination of the second type of triggering event if the seed pool is not full (UTZ col.3 lines 38-40; col.11 lines 51-55).

It would have been obvious to a person of average skill in the area at the time of the invention to include within Schneier the Utz's ability to determine if a seed pool is full and masking bits into the seed pool in order to allow the cryptographic security subsystem in knowing when the pool is full and available for use in creating a random number.

Regarding **claim 37**, Schneier further discloses wherein the triggering even comprises receipt of a query from a device external to the computer system (page 426 lines 12-13).

Regarding **claim 38**, Schneier further discloses wherein writing bits to the seed pool in discrete increments corresponding to the triggering even comprises masking bits

into the seed pool in discrete increments corresponding to a power cycle of the computer (page 426 lines 12-13).

Regarding **claim 39**, Utz further discloses wherein tracking the state of the seed pool comprises examining a state bit, wherein the state bit changes when the seed pool is fully populated (column 7 lines 21-25 and 60-62).

Regarding **claim 40**, Utz further discloses wherein tracking the state of the seed pool comprises examining the position of a pointer to determine whether the portion of the nonvolatile memory storing the seed pool is full (column 7 lines 21-25 and 60-62)..

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

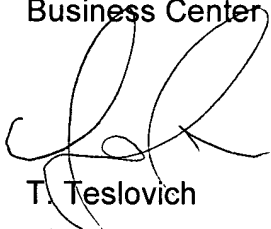
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamara Teslovich whose telephone number is (571) 272-4241. The examiner can normally be reached on Mon-Fri 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



T. Teslovich



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